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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,970	11/03/2003	Steffen Arnold	102132-16 CH	5020

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EXAMINER	
HAND, MELANIE JO	
ART UNIT	**PAPER NUMBER**
3761	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/699,970	ARNOLD, STEFFEN	
	Examiner	Art Unit	
	Melanie J. Hand	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 11/3/03 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2/9/04

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. DE 102 51 598.0, filed on November 6, 2002.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on February 9, 2004 was filed after the mailing date of the Application on November 3, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moberg et al (U.S. Patent No. 5,230,704).

With respect to **Claim 1,10:** Moberg teaches suction/irrigation instrument 10 comprising a disposable cartridge 12 having an opening 96 adapted to receive mating plug 98 that is removable to provide access to the lumen of sleeve 94, thus permitting an electrosurgical scalpel to be passed down the lumen of rigid tube 30 during a surgical procedure. (Col. 3, line 35, Col. 5, lines 12-19) Flexible tubes 46 and 48 that supply flows of suction and irrigation fluid, respectively are coupled to sleeve 94. (Col. 5, lines 7-12) Moberg teaches a trigger and lever mechanism located on said device 10 that allows the operation of the suction and irrigation flows from device 10 having backup cartridge 13 that is configured to allow gripping of said device by a user's hand. (Col. 3, lines 35-38, Col. 5, lines 58-68, Col. 6, lines 1-4)

Moberg teaches that the trigger and lever mechanism acts to crimp tubes 46 and 48 to shut off flow, but does not explicitly teach that device 10 comprises or communicates with any valves. Moberg does however teach that a typical prior art suction/irrigation device does use flow valves to regulate the flow of suction or fluid to a procedure site (Col. 1, lines 45-49), therefore it would be obvious to modify the device 10 taught by Moberg to employ flow valves that are in operative communication with handheld device 10 and suction and/or fluid sources.

With respect to **Claim 2:** Moberg teaches "a source of irrigation liquid, such as saline under pressure" (Col. 5, lines 58-60), which implicitly teaches a container associated with an irrigation source, and a collection chamber associated with a vacuum source. (Col. 6, lines 2,3). Since these sources are remote, they are considered herein to be operated manually.

With respect to **Claim 5:** Moberg teaches that the irrigation fluid is saline and under pressure and coupled to end 92 of tube 48, therefore said irrigation container is both removable and sealable.

With respect to **Claim 6:** Moberg is silent regarding a particular container for the irrigation source, however a container that can house a supply of saline under pressure is capable of also housing waste material suctioned from a wound site and therefore can be interchanged so as to be associated with either the suction source or the irrigation source.

With respect to **Claim 8:** Moberg teaches a trigger and lever mechanism that allows fluid flow from either said suction source or said irrigation source to continue through tube 30 to the procedure site, but does not allow simultaneous deployment of both sources.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moberg ('704) in view of Stahl (U.S. Patent No. 6,679,834).

With respect to **Claims 3,4:** Moberg teaches a vacuum source, considered herein to implicitly teach a suction pump. Moberg teaches saline under pressure as the irrigation fluid but does not explicitly teach a fluid pump associated with the irrigation source. Stahl teaches that having a pump-driven irrigation system is known in the art ('834, Col. 1, line 46), therefore it would be obvious to one of ordinary skill in the art to modify the irrigation source taught by Moberg so as to comprise or be coupled to a pump.

Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moberg ('704) in view of Arias et al (U.S. Patent No. 5,429,596)

With respect to **Claims 7,11:** Moberg teaches a spring-biased lever mechanism that opens or closes tubes 46,48 to fluid flow, however Moberg does not teach a transverse member comprising bores actuated by a slider wherein plungers associated with suction and irrigation sources are aligned with said bores. Arias teaches a locking pin mechanism 536 having locking pin 536a having flange 536b within housing 102, spring 536d, lever 536f, lever pivot 536g and button plunger 536h with flange 536i. The following excerpt from the prior art of Arias explains the locking pin mechanism:

> FIG. 5d shows an alternate embodiment of the locking pin mechanism. In the embodiment of FIG. 5d, pulling on the probe will not release the probe from the locking pin. Rather, the locking pin mechanism 536 requires an active release. In particular, the locking pin mechanism of FIG. 5d, includes a locking pin 536a with a flange 536b and tab 536c, a spring 536d, a stationary spring stop or housing 536e, a lever 536f, a lever pivot 536g, and a button plunger 536h having flange 536i. With the provided arrangement, the locking pin 536a is spring biased by the spring 536d (which sits between housing 536e and tab 536c) so that the end of the locking pin 536a extends through housing 102 and can engage a detent in a probe. The flange 536b on the locking pin 536a stops the locking pin in a defined position. When the locking pin 536a is locked in a detent or groove of a probe, pushing on the plunger 536h (which also extends out of housing 102) releases the probe. The probe is released, because by pushing on lever 536f, the lever 536f rotates around pivot 536g, and pushes the locking pin 536a upwards by its tab 536c against the force of the spring 536d. Upon release of plunger 536h, the spring 536d forces the locking pin 536a downward until the pin is stopped by flange 536b. Likewise, lever 536f is pushed in the opposite direction, and pushes button plunger 536h upward until it is stopped by flange 536i. ('596, Col. 12, lines 58-68, Col. 13, lines 15)

Locking pin 536a is configured to fit into detents 518 and 520 of probe 500, corresponding to the most retracted and forward positions of probe 500. It would be obvious to one of ordinary skill in the art to employ this mechanism to engage triggers 38 and 40 taught by Moberg with a

reasonable expectation of success as the devices are analogous and each of the methods of the trigger-lever mechanism with a spring-biased slider as taught by Moberg and the locking pin mechanism of Arias are capable of accomplishing the identical goal of alternately actuating suction and irrigation flow with a substantially identical structure. In the instant case substitution of equivalent methods requires no express motivation, as long as the prior art recognizes equivalency, *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.* 85 USPQ 328 (USSC 1950).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moberg ('704) in view of Sakurai (U.S. Patent No. 5,151,085).

With respect to **Claim 9:** Moberg does not teach a slider mechanism for accomplishing the alternating operation of the suction and irrigation flows. Sakurai et al teaches a handheld ultrasonic device for use in surgical operations that utilizes handle 149 and slider 150 biased by spring 151. When handle 149 is actuated, spring 151 exerts a force upon slider 150 which then pushes suction tube 145 having conduit 146 that communicates with suction tube 147 so as to protrude said tube 145 from the distal end of tube 148 to be applied to a surgical site. ('085, Col. 17, lines 63-68, Col. 18, lines 1-3) Sakurai teaches that this device may be used in ultrasonic surgical knife operations as a cutting tool ('085, Col. 18, lines 17-20) as could the device of Moberg, therefore it would be obvious to one of ordinary skill in the art to add a handle 149 and slider 150 with spring 151 as taught by Sakurai to the device of Moberg with a reasonable expectation of success as Moberg teaches spring-biased levers that provide the valve mechanism that opens and closes each of tubes 46 and 48.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie J Hand
Examiner
Art Unit 3761

MJH

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER